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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,644	09/27/2003	Scott McCleskey	4472 P	8219

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EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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10/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/672,644

Applicant(s)

MCCLESKEY ET AL.

Examiner

James W. Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/27/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the initial filing on September 27, 2003.
Claims 1-27 are currently pending and have been considered below.

Information Disclosure Statement

2. The Examiner notes that due to the enormous number of documents cited on the nine-page information disclosure statement filed on September 27, 2003 only a cursory review could be performed. No judgment is hereby made on the pertinency of the cited documents. The Applicant is reminded that such voluminous filings give the appearance that the Applicant is attempting to hide pertinent art. The Applicant is requested to identify the most pertinent prior art and to explain how each reference differs from the claimed invention.

Oath/Declaration

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration filed on June 18, 2004 is defective because:

- a. Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

b. The prior provisional application number is incorrect. Provisional applications filed with the United States Patent and Trademark Office all begin with 60, not 80. The Examiner will assume the Applicant's priority application is provisional application 60/252,334.

Appropriate corrections are required.

Specification

4. The disclosure is objected to because of the following informalities:
 - a. On page 1, line 4, the provisional application number should begin with 60, not 80 (see Oath and Declaration discussion above).
 - b. On page 28, line 10 the phrase "also has a unique digital" is repeated twice.Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 8, 15, 16, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 and 18 recite the limitation "said user's preferences and profile" and "said stored data related to the profile of the user" respectively in line 3. There is insufficient antecedent basis for these limitations in the claims. Since the first

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introduction of storing user preferences and profile is in Claim 5, the Examiner believes that both of these claims should depend from Claim 5, not Claim 1 or Claim 4, and will examiner them in that light below.

Claims 15 and 16 recite the limitation "a digital trigger". However, their parent, Claim 1, recites "a digital acknowledgement trigger". It is unclear on whether the two triggers are the same or whether a different trigger is being created and modified by Claims 15 and 16. The Examiner will consider them to be the same "digital acknowledgement trigger" during the prosecution below.

Appropriate corrections are required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-21 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Dedrick (5,724,521).

Claim 1: Dedrick discloses a method for distributing digital data files, comprising:

- a. receiving user registration data (column 3, lines 29-60);
- b. downloading a digital acknowledgement trigger (tracking software) to the client computer of the user (column 3, lines 29-60 and column 17, lines 30-35);

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- c. searching for a digital data file (column 3, lines 29-60);
- d. selecting one or more advertisements for choice of viewing by the user (column 10, lines 45-63);
- e. choosing by the user an advertisement to view (column 10, lines 45-63); and
- f. downloading and accessing the digital data file (column 10, line 64 – column 11, line 6).

Claim 2: Dedrick discloses a method as in Claim 1 above, and further discloses identifying the user demographically (column 3, lines 29-60).

Claims 3 and 8: Dedrick discloses a method as in Claim 1 above, and further discloses assigning a unique digital acknowledgement trigger to the user associated with the user and the user preferences and/or profile (column 3, lines 29-60).

Claim 4: Dedrick discloses a method as in Claim 1 above, and further discloses providing one or more advertisements to the user (column 10, lines 45-63).

Claims 5 and 17: Dedrick discloses a method as in Claim 1 above, and further discloses storing data related to the preferences and/or profile of the user (column 3, lines 29-60).

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Claim 6: Dedrick discloses a method as in Claim 1 above, and further discloses calculating a royalty (payment) based on the downloaded file and the viewed advertisement (column 5, lines 30-64 and column 12, lines 31-48).

Claim 7: Dedrick discloses a method as in Claim 5 above, and further discloses selecting the advertisements based on the stored preferences and/or profile of the user (column 10, lines 45-63).

Claim 9: Dedrick discloses a system for distributing digital data files, comprising:

- a. a user computer system, a server computer system, and a network connecting them (column 2, line 54 – column 3, line 28);
- b. a digital acknowledgement trigger (tracking software) installed in part of the user computer system (column 3, line 29 – column 4, line 2 and column 7, lines 1-15); and
- c. a database storing a collection of digital files (column 2, line 54 – column 3, line 28).

Claim 10: Dedrick discloses a system as in Claim 9 above, and further discloses the network is the Internet, a wide-area network, a wireless network, a telephone network, a broadband network, a cable network, a satellite network, a local area network, or a digital distribution network (column 2, line 54 – column 3, line 28).

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Claim 11: Dedrick discloses a system as in Claim 9 above, and further discloses the digital files are audio files, video files, graphics files, text files, software files, game files, or multi-media files (column 4, lines 8-15 and column 13, lines 7-11).

Claim 12: Dedrick discloses a system as in Claim 9 above, and further discloses the digital acknowledgement trigger is a mechanism for selecting advertisements, a mechanism for viewing advertisements, or a mechanism for generating royalties from said viewed advertisements (column 7, lines 1-15 and column 3, line 29 – column 4, line 2).

Claim 13: Dedrick discloses a system as in Claim 9 above, and further discloses downloading the desired digital data files (column 10, line 64 – column 11, line 6).

Claim 14: Dedrick discloses a system as in Claim 9 above, and further discloses paying royalties to owners of the digital data files (column 5, lines 30-64 and column 12, lines 31-48).

Claims 15 and 16: Dedrick discloses a method as in Claim 1 above, and further discloses creating and modifying the digital acknowledgement trigger (column 3, lines 29-59).

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Claims 18-21: Dedrick discloses a method as in Claim 1 above, and further discloses selecting the advertisement based on the stored information related to the user preferences and/or profile, the advertisement, and/or the content/context of the digital data file (column 5, lines 14-29).

Claim 25-27: Dedrick discloses a system as in Claim 9 above, and further discloses the user computer system could be "a personal computer" or "any other type of consumer consumption device, such as a television set, a game machine, etc." (column 2, lines 58-62 and column 6, lines 33-54). This would include the claimed "wireless communication device", "personal data assistant", and "MP3 player" or any other electronic device capable of being programmed to do the above functions. The Examiner further notes that the personal computer in Dedrick could be considered all three also, since it could be wireless attached to the network (e.g. laptop computer), hold personal data pertaining to the user (i.e. perform as a personal data assistant), and play MP3 files (i.e. perform as an MP3 player).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick (5,724,521).

Claims 22-24: Dedrick discloses a method as in Claim 1 above, and further discloses not allowing the user to view the selected advertisement and/or digital data file (content) until certain criteria are met, such as the user account having sufficient funds (column 12, lines 31-48 and column 15, line 65 – column 16, line 18). While it is not explicitly disclosed that the digital data file is made inaccessible to the user by locking the file and/or encrypting the file, Official Notice is taken that it is old and well known to prevent access to files by encrypting or locking files, especially if the data file contains sensitive personal or proprietary information. It is also well known to provide advertisements online that pop-up ahead of or on top of the requested data file when a user is browsing on the Internet. In these instances, the user is exposed to the advertisement and must click on or somehow close the advertisement page before being able to view the requested data file. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to lock or encrypt the digital data file (content) to prevent the user in Dedrick from receiving or viewing the requested file until the advertisement has been viewed. One would have been motivated to use such measures to prevent the viewing of the content file in view of the discussion in Dedrick about using the payments the user receives for advertisement viewing to pay for viewing the content files. By requiring the user to view the advertisement(s) first, the user's account would be credited with the viewing credits, thus allowing the royalties to

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be deducted from the account once the user views the digital data file, especially if Dedrick determines the user account had insufficient funds to view the data file as discussed therein.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JWM
October 9, 2007



James W. Myhre
Primary Patent Examiner